

Application No. 09/708,475  
Art Unit 1624

February 28, 2003

Remarks

Reconsideration of the Examiner's Action dated August 30, 2002 is requested.

Status of the Claims

The Examiner's Action addresses all of the applicants' pending claims, namely Claims 1 to 75 and 77 to 147. Claims 1, 80, 87, 104, and 132 have been amended. No claims have been added. No claims have been cancelled. Accordingly, there is presented for the Examiner's consideration Claims 1, 80, 87, 104, and 132.

Summary of the Examiner's Rejections

Claims 78 and 82 to 86 have been rejected under 35 U.S.C. § 102 as being anticipated by the disclosure of Strupczewski (EP 402,644). Claims 1, 67 to 75, 77 to 78, 80 and 82 to 147 have been rejected under § 112. Claims 2 to 66, 79, and 81 have been objected to as being dependent on rejected base claims.

Reconsideration of the Examiner's rejections is requested respectfully.

Discussion of the Examiner's §102 Rejection in Paragraph 4. of the Action

The Examiner's §102 rejection of Claims 78 and 82 to 86 based on EP 402,644 is traversed respectfully. This rejection was made also by the Examiner in her earlier Action dated December 14, 2001. In their Reply dated June 13, 2002, applicants pointed out that EP 402,644 (published on December 19, 1990) is not a

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prior art publication because the subject matter of the rejected claims is described in applicants' earlier filed priority application which has a filing date (December 29, 1989) which antedates the December 19, 1990 publication date of EP 402,644. Unfortunately, the Application No. of the priority application was identified incorrectly in the June 13 Reply. The correct Application No. of the priority application is 07/456,790, of which the application which issued as involved Patent No. 5,364,866 is a continuation-in-part, as referred to in column 1 of the Patent. Applicants submit that the definition of R as alkanoyl appears in priority Application No. 07/456,790, page 8, line 11 (copy enclosed herewith).

Accordingly, applicants request that the § 102 rejection be withdrawn.

Discussion of the §112 Rejections in Paragraph 2. Of the Action

The Examiner earlier issued a rejection of Claims 78 and 82 to 86 on the basis that applicants' description does not describe those compounds in which R is an alkanyol (see the Office Action dated December 14, 2001). In the Reply dated June 13, 2002 in response to that Action, applicants referred the Examiner to U.S. Patent No. 5,384,866, column 24, line 58.

In the present Action, the Examiner has rejected these claims for the reason that some of the species recited in the rejected claims are not described in the aforementioned column 24. Applicants acknowledge that the Examiner is correct in her observation. However, all of the claimed species, including C<sub>1</sub>-C<sub>6</sub> alkanoyl, amino, dialkyl amino, acylamino, and lower alkyl-C(=O)-, are described in other portions of the application, such as: col. 4, lines 51 to 65; col. 8, line 62 through col. 9, line 7; and col. 17, lines 34 to 47 of involved U.S. Patent No. 5,384,866.

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In view of the description in the application of the aforementioned species, a withdrawal of the rejection is requested respectfully.

Discussion of the §112 Rejections in Paragraph 5. Of the Action

It is submitted respectfully that amendments to Claims 1, 80, 87, 104, and 132 overcome various of §112 rejections of these claims, as discussed below in paragraphs which correspond to various of the subparagraphs which appear in paragraph 5. of the Action.

- a) A hyphen (the bond) at the end of the moiety  $-\text{CH}_2-\text{CH}=\text{CH}-\text{CH}_2-\text{CH}_2$  in Claim 1 has been deleted to have the moiety conform to the moiety recited in original Claim 1, col. 112, line 12, of involved U.S. Patent No. 5,364,866.
- b) A circle has been inserted to replace the three double bonds in the six-member ring in Claim 1 to have it conform to the species recited in original Claim 1, col. 112, line 24, of involved U.S. Patent No. 5,364,866.
- c) The word "or" has been inserted between the last two moieties of  $\text{R}_5$  in Claim 1.
- e) A circle has been inserted to replace the three double bonds in the six-member ring in Claim 80 to have it conform to the species recited in original Claim 80, col. 119, line 19, of involved U.S. Patent No. 5,364,866.
- r) The term "or" has been inserted between the last two moieties of the

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definition of  $R_5$  in Claim 87.

- s) The term "or" has been inserted between the last two moieties of the definition  $R_5$  in Claim 104.
- t) The term "or" has been inserted between the last two moieties of the definition  $R_5$  in Claim 132.

Additional amendments to Claims 1, 80, 87, 104, and 132 include insertion of the term "wherein" in the claims as appropriate.

In subparagraphs 5. d), f), g), h), i), j), k), l), m), n), o), p) and q) of the Action, the Examiner rejected Claim 80 and claims dependent thereon as including recitations for which there is insufficient antecedent basis or as being vague. This rejection is traversed respectfully.

Claim 80 in involved U.S. Patent No. 5,364,866 is in independent form, whereas, in the present application, Claim 80 is dependent on Claim 1. The Examiner is referred to applicant's Reply of June 13, 2002, page 8, last line, in which there appears in amended Claim 80 an open bracket, and to page 11, line 3, in which there appears in amended Claim 80 a closed bracket, indicating the text to be deleted. The recitations referred to in all of the aforementioned subparagraphs of the Action appear within the brackets and, accordingly, the involved recitations have been deleted from Claim 80.

Accordingly, it is requested that the § 112 rejections of Paragraph 5 of the Action be withdrawn.

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Discussion of the Claim Objections in Paragraph 6. Of the Action

The Examiner has objected to Claims 2 to 66 and 81 as being dependent upon rejected base claims. It is believed that all of the base claims are now in allowable condition and, thus, a withdrawal of the objection to these claims is requested respectfully.

The Examiner has objected also to Claim 79 as being dependent upon a rejected base claim; applicants point out respectfully that Claim 79 is an independent claim.

Conclusion

In view of the foregoing amendments and remarks, applicants request respectfully that applicants' claims be allowed.

If the Examiner believes that there are matters that require additional attention in order to place the present Application in condition for allowance, the Examiner is invited to telephone the undersigned.

A Petition for a three-month extension is being filed concurrently herewith.

Respectfully submitted,  
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heteroaryl is

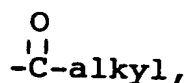


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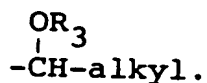
Q is -O-, -S-, -NH-, -CH=N;

R<sub>3</sub> is hydrogen, lower alkyl, or acyl; and  
m is 1, 2, or 3.

When the compounds of the invention contain two or three R-substituents, each of the R-substituents can be independently selected from the above substituents. Preferably, each of the R-substituents is selected from the group consisting of hydrogen, C<sub>1</sub> - C<sub>3</sub> alkyl, C<sub>1</sub> - C<sub>3</sub> alkoxy, hydroxy, acyl, alkanoyl, Cl, F, Br, I, C<sub>1</sub> - C<sub>3</sub> alkyl amino, -NO<sub>2</sub>, -CF<sub>3</sub>, -OCF<sub>3</sub>,



and



The compounds of the present invention are prepared in the following manner. The substituents R, R<sub>1</sub>, R<sup>2</sup>, R<sub>3</sub>, X, Y, and Z and the integers m, n, and p are as defined above unless indicated otherwise.